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| EXAMINER |
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| NGUYEN, QUYNH H |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *RCE and amendment filed 3/4/09*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *21-40* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

# DETAILED ACTION

1.      The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

## *Claim Rejections - 35 USC § 101*

2.      35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or

any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and

requirements of this title.

Claims 21-25 are rejected under 35 U.S.C. 101 as not falling within one of the

four statutory categories of invention. Supreme Court precedent (*Diamond v. Diehr*, 450

U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584 n.9 (1978); *Gottschalk v. Benson,*

409 U.S. 63, 70 (1972); *Cochrane v. Deener,* 94 U.S. 780, 787-788 (1876)), and recent

Federal Circuit decisions *(In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) indicate that a

statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category

(such as a particular apparatus), or (2) transform underlying subject matter (such as an

article or material) to a different state or thing.  While the instant claim recites a series of

steps or acts to be performed, the claim neither transforms underlying subject matter

nor is positively tied to another statutory category that accomplishes the claimed

method steps, and therefore does not qualify as a statutory process.

Claims 31-35 recite "computer readable medium" while Applicant's specification

paragraph [0070] discloses "...a digital file attachment to email or other self-contained

information archive or set of archives is considered a distribution medium..." is not

tangibly embodied in a physical medium and encoded on a computer-readable medium.

### Claim Rejections - 35 USC § 103

3.       Claims 21, 26, 31, and 35-36 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Miloslavsky (US Patent 5,905,792).

As to claims 21, 26, 31, and 36, Miloslavsky teaches the steps of:

receiving, by a personal caller identification server (col. 6, lines 24-27 - *telephony*

*server 207*), a calling party number in response to a telephone call (Fig. 4, 413; Fig. 5,

501; col.3, lines 26-27; col. 6, lines 24-27);

using the calling party number, to retrieve personal caller identification

information associated with the calling party number (col. 2, lines 50-55; col. 8, lines 15-

19);

querying, by the personal caller identification server (col. 6, lines 24-27), a central

network-based personal address book (col. 2, lines 55-60) which is distinct from the

network caller identification database (col. 2, lines 50-60), using the calling party

number, to retrieve personal caller identification information associated with the calling

party number (col. 2, lines 50-60; col. 4, line 66 through col. 5, line 6; col. 13, lines 12-

17); and

forwarding the network caller identification information (col. 2, lines 50-55) and

the personal caller identification information to a destination associated with the

telephone call (col. col. 2, lines 55-60; col. 3, lines 49-50; col. 5, lines 1-8; col. 8, lines

15-19);

Miloslavsky does not explicitly teach querying, by the personal caller identification server, a network caller identification database.

However, Miloslavsky teaches when a call is arrived at a call center, information about the call, for example, caller identification information, is sent to a routing server as part of telephony server 207 which routes the call to an agent (col. 7, lines 44-54).

Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made that in order to be able to send information about the call to a routing server as part of telephony server 207 which routes the call to an agent, the information has to be retrieved from a network caller identification database that stored in a network, for example, database in PSTN or SCP.

As to claim 35, Miloslavsky teaches customer database is maintained on a data file server and a stat server track and providing data (col. 7, lines 60-67). Hence, it would have been obvious that one can add / modify entry to the address book during a web browsing session. Retrieving, adding, deleting, modifying, etc. functions being perform on a database is well known.


4.      Claims 22-25, 27-30, 32-34, and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miloslavsky (US Patent 5,905,792) in view of DeFazio et al. (US 5,940,484).

As to claims 22 and 37, Miloslavsky teaches receiving a called party number at a network service platform in response to the telephone call (col. 7, lines 44-59 - *where Miloslavsky discussed routing the call to the designated agent in response to a call,*

*hence the called party or designated agent number has to be received prior to route the call*).

Miloslavsky does not teach determining that a party associated with the called party number subscribes to a personal identification service; and forwarding the calling party number to the personal caller identification server based upon the determination that the party subscribes to the personal caller identification service.

DeFazio teaches determining that a party associated with the called party number subscribes to a personal identification service (Fig. 3A, step 305; col. 5, line 66 through col. 6, line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of DeFazio into the teachings of Miloslavsky for the purpose of having a more efficient system and this is the only obvious way that central office or service provider would only provide service if user subscribed for the service, the forwarding the caller identification to the database or server for providing caller identification when requested.

Claims 23, 28, 33, and 39 are rejected for the same reasons as discussed above with respect to claim 21. Furthermore, Miloslavsky teaches routing server routes incoming call to the designated agent (col. 7, lines 44-59); hence the called number of the designated agent is known by a network element that handling the telephone calls.

As to claims 24 and 40, Miloslavsky teaches forwarding the network caller identification information and the personal caller identification information to the party associated with the called party number (col. 2, lines 50-60; col. 7, lines 44-59 -

*forwarding caller identification information and personal caller identification to an agent /*

*the designated agent, hence the forwarding information associated with the agent's*

*number).*

As to claims 25, 29, 34, and 38, Miloslavsky teaches the network service platform

comprises one of a SCP (Fig. 1, SCP 101; col. 5, lines 36-57), SIP feature server, and

Parlay gateway.

As to claims 27 and 32, Miloslavsky teaches receiving the calling party number

from a network service platform (col. 2, lines 50-53).

As to claim 30, Miloslavsky teaches customer database is maintained on a data

file server and a stat server track and providing data (col. 7, lines 60-67).  Hence, it

would have been obvious that one can add / modify entry to the address book during a

web browsing session.  Retrieving, adding, deleting, modifying, etc. functions being

perform on a database is well known.


### Response to Arguments

5.      Applicant's arguments with respect to claims 21-40 have been considered but are

moot in view of the new ground(s) of rejection.


6.      Any inquiry concerning this communication or earlier communications from the

examiner should be directed to QUYNH H. NGUYEN whose telephone number is 571-

272-7489.  The examiner can normally be reached on Monday - Thursday from 6:30

A.M. to 5:00 P.M.  If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).


/Quynh H Nguyen/

Primary Examiner, Art Unit 2614